

Applicant respectfully submits that this characterization of Totaro is totally at variance with the disclosure of Totaro. The Examiner's attention is directed, in particular, to Column 1, lines 11 through 17, which states:

More particularly, the present invention is concerned with a tool for automatically carrying out a picking up and elimination of the liquid from water jets coming from hydric injectors of conventional tools, sucking the water from a collection cavity which the operator adjusts each time in accordance with contingent use requirements.

Additional evidence of the total inapplicability of Totaro is found when one reads the description of the process commencing at Column 3, line 63, which states:

The improved dental process treatment according to the present invention comprises placing the above described sheet over the oral cavity and on a treatment area of the teeth to be treated, making at least one bore or opening in the sheet at a point corresponding to that area, clamping the sheet to the treatment area at the bore or bores; placing the aspirating frame against the sheet and aspirating liquid and solid on the sheet through the bores 3 and 4 into conduits 1 and 2, respectively as the treatment is carried out.

Also, of interest is the language contained in Column 3, lines 57 through 60:

Referring more particularly to Fig. 2, the sheet 6 is formed of rubber or flexible, preferably air-permeable plastic and of a size such that the mouth of the patient is not covered.

In short, Totaro discloses a dental treatment process wherein it is desired to prevent liquid, used in a dental process on one or more teeth, from entering the mouth of the patient. In use, sheet 6 is placed over the mouth of the patient, as shown in Figure 2, and more particularly in Figure 3. A hole is then made in the sheet to permit one or more teeth, which are to be treated, to pass through the sheet, and a clamp is utilized to hold the sheet in position on the tooth or teeth. This is effectively illustrated in Figure 3 of Totaro.

After the sheet has been positioned on the patient, the

The Examiner's attention is respectfully called to the decision of the United States Court of Appeals for the Federal Circuit in the matter of In Re John R. Fritch, 972 F2d 1260 (CAFC 1992), which decision was handed down on August 11, 1992. In particular, the Examiner's attention is called to the language of the Court occurring on page 1266:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. (emphasis in the original).

The Court further states on page 1266:

. . . It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'

Applicant respectfully submits that nothing in any of the references cited by the Examiner even remotely hints at her unique invention. Applicant further submits that nothing in any of the prior art cited by the Examiner even remotely hints at any reason to make a combination of the various pieces of the prior art to create her unique invention. Further, applicant submits that this is a clear case of the Examiner using applicant's invention as a template to piece together the teachings of prior art so as to construct an obviousness rejection.

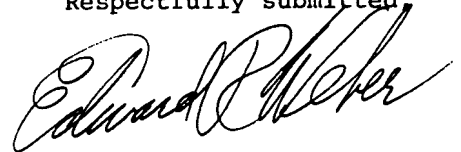
The Examiner has also rejected Claim No. 12 under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner states:

. . . The claim is improperly alternative since plastic

Applicant traverses this rejection, since the material of construction would not change the characteristics of the device. To expedite prosecution of the application, however, applicant has amended Claim No. 12 to delete plastic and has added new Claim No. 22, which is identical to Claim No. 12, except the material of construction is plastic.

In view of the foregoing, applicant submits that Claim Nos. 1 through 22, all the claims currently in the application, are clearly patentable under either 35 U.S.C. 102 or 35 U.S.C. 103, and are fully in compliance with 35 U.S.C. 112, first and second paragraphs. Applicant therefore submits that the case is in condition for allowance. The Examiner is respectfully requested to issue a Notice of Allowance at an early date.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on June 29, 1993

